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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/552,087

04/21/2000

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02/16/2007

EXAMINER

SWITZER, JULIET CAROLINE

ART UNIT

PAPER NUMBER

1634

MAIL DATE

DELIVERY MODE

02/16/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/552,087

Applicant(s)

BYRUM, JOSEPH R.

Examiner

Juliet C. Switzer

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because: Regarding the rejection for lack of utility, applicant states that one utility can be shown in a BLASTN analysis, continuing that SEQ ID NO: 1 can be used to isolate genes, map genes, and determine function associated with nitrogen fixation. Regarding the first two, generally isolating genes and mapping genes are not utilities that are specific and substantial under 101, for reasons previously discussed of record. Regarding determining function associated with nitrogen fixation, this utility is not asserted in the specification, and therefore cannot be considered as an asserted specific, substantial and credible utility at the time of filing. The nucleotide sequence to which applicant refers in their arguments was not in the NCBI database at the time of filing. Post-filing data cannot be used to establish the utility and enablement of a claim. Applicant points out that SEQ ID NO: 1 might contain any combination of an mRNA transcript, a promoter element or part of a promoter, microsatellites or fragments thereof or other DNA markers. Applicant has not disclosed which of these is present in SEQ ID NO: 1, nor has applicant provided any guidance particular to SEQ ID NO: 1 to determine which is present. The utility rejection is maintained.

Applicant states that claim 10 was not rejected under 112 1st paragraph. This is not correct. See page 13 of the office action mailed 10/30/06. Claim 10 is not recited in the statement of rejection for 112 1st paragraph rejection on page 14, but this is clearly a typographical error since the claim is specifically addressed in the body of the rejection on page 15. The examiner regrets the confusion.

Applicant points out that the presence or absence of a working example cannot be the basis for an enablement rejection, however the examiner reiterates that it is a factor to be considered especially in a case involving an unpredictable and undeveloped art. The prior art as it relates to SEQ ID NO: 1 and constructs that comprise SEQ ID NO: 1 is an UNDEVELOPED art as this sequence is first disclosed in the instant specification. Further, even though the change would involve at most 118 nucleotides this is still a large number of substitutions given the potential for the effect of the substitution on the function of the molecule. While conservative substitutions generally do not effect nucleic acid function, they sometimes do by effecting transcript stability, for example, and when this might occur is highly unpredictable. Further, there is no known means for determining a conservative substitution in a non-coding region, which instant SEQ ID NO: 1 may be, or may be in part. The rejection is maintained.

The rejections for written description and under 102(b) are WITHDRAWN. The examiner regrets the confusion and the repeated editing error.



JULIET C. SWITZER
PRIMARY EXAMINER